

First named inventor: Rohde
Serial no. 10/760,044
Filed 1/18/2004
Attorney docket no. 1048.004US1

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REMARKS

Claims 1-7, 9-11, 13-17, and 19-20 have been cancelled without prejudice, rendering the rejections of these claims moot. As such, the rejections of these claims are not discussed further herein. Remaining independent claims 8 and 18 have been substantially amended as recited above. Claim 12 remains as a dependent claim to claim 8, and claim 21 has been added as a dependent claim to claim 21 that mirrors dependent claim 12. Applicant respectfully submits that independent claims 8 and 18 at least as amended are patentable over the cited prior art of record. As such, claims 12 and 21 are patentable at least because they depend from patentable base independent claims. The patentability of claims 12 and 21 is now discussed.

Claim 12 has been rejected under 35 USC 102(e) as being anticipated by Howard (2004/0133582). Insofar as claim 12 now includes a credit-accepting mechanism that the Examiner found in Walker (6,110,041), Applicant respectfully submits that claim 12 is now properly rejected under 35 USC 103(a) over Howard in view of Walker, but traverses this rejection. Claim 18 has been rejected under 35 USC 102(a) as being anticipated by Family Tree DNA and under 35 USC 103(a) as being obvious over Howard. However, insofar as claim 18 now recites specific types of biometric information that do not include DNA, the Family Tree DNA reference is irrelevant; indeed, it is questionable in the first instance as to whether DNA is even considered biometric information by those of ordinary skill within the art. Furthermore, insofar as claim 18 now includes a credit-accepting mechanism that the Examiner found in Walker, Applicant respectfully submits that claim 18 is now properly rejected under 35 USC 103(a) over Howard in view of Walker, but traverses this rejection.

Applicant would like to focus on claims 12 and 18 "as a whole" to explain why claims 12 and 18 are patentable over the prior art. It is noted that the claimed invention is directed to an "entertainment machine." As such, for instance, the output mechanism entertains one or two customers by providing certain indications. All of the mechanisms are disposed within a housing that is suitable for placement in a public place. The credit-accepting mechanism of the machine

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accepts cash-oriented credit (e.g., like a dollar bill, etc.) from the customer(s), and responsive to the acceptance of the credit, the biometric acquisition mechanism acquires biometric information of the customer(s), and the comparison mechanism performs a comparison based on this biometric information.

Thus, the idea here is that Applicant novelly uses biometric acquisition and matching to entertain a paying customer, all encased within a machine. Applicant envisions that the machine may be placed in bars, restaurants, airports, and other public venues. Applicant is unaware of any existing entertainment machines that entertain one or two customers that provide a cash-oriented credit, and in response have their biometric information acquired, and thereafter is provided with entertaining information based on the biometric information acquired.

That is to say, Applicant is not contesting that the acquisition of biometric information nor that the comparison of biometric information is in and of itself patentability. Rather, the patentability of the claimed invention stems from the fact that within a single machine that can be placed in a public place, the machine can provide entertainment to customers in exchange for the customers providing money (e.g., cash-oriented credit). This type of machine is akin to a video arcade machine, a video poker machine, etc., but focuses on novelly and inventively providing entertainment via biometric information acquisition and comparison.

The Examiner has very expertly sewn together Howard and Walker to show how the various types of biometric acquisition and comparison achieved in the invention are found within the prior art. However, the novelty of the invention does not lie in its individual biometric acquisition and comparison limitations. Rather, the novelty of the invention lies in the recitation of each independent claim *as a whole* – a single entertainment *machine* that is able to perform certain functionality to *entertain* one or two paying customers.

Indeed, the well known nature of biometric acquisition and comparison compels the conclusion of the patentability of the claimed invention, Applicant asserts. Yes, Howard does teach that in computer dating and model/actor searching scenarios biometric acquisition and

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comparison are undertaken. However, what Howard in view of any other reference does not suggest is the claimed invention *as a whole*, considering the claimed invention *as a whole* – that is, a single entertainment machine that entertains one or two paying customers in a public place based on acquisition and comparison of these biometric information of these customers. That is to say, insofar as biometric acquisition and comparison is well known, it behooves the conclusion of patentability of the claimed invention that no one until the inventor has actually used such biometric acquisition and comparison in a novel single entertainment machine that is located in a public place and that accepts money from paying customers.

To further explain, Applicant is unaware of any existing singles machine that is specifically to entertain paying customers in a public setting. For example, as to computer dating, while this may entertain paying customers, the functionality of computer dating is not performed within a single machine. Typically a customer mails photos of him or herself, for instance, or goes to a private location – the office of a computer dating agency – to have biometric information of him or herself taken. The customer does not interact with a single entertainment machine that both takes his or her money and performs the biometric functionality recited in the claimed invention. Having these functions performed by disparate entities (for instance, giving your credit card number to a salesperson, who then takes your photo, etc.) just does not rise to the level of the claimed invention.

For all of these reasons, Applicant respectfully submits that the claimed invention as has been amended is patentable. Applicant underscores the fact that the claimed invention as a whole has to be considered, not the individual parts of the invention. It is the combination of all the aspects of the invention that result in a novel and inventive single entertainment machine. To be sure, biometric acquisition and comparison is known (as Howard demonstrates) and accepting credit is known (as Walker demonstrates). What is not known, and what is non-obvious and thus patentable, is the unique combination that results in the inventive single entertainment machine

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contemplated by the inventor. On this basis, Applicant respectfully requests that the Examiner reconsider his finding of unpatentability.

In conclusion, Applicant would like to state that while it is believed that the invention is patentable over the cited prior art of record, Applicant understands that reasonable minds can disagree as to whether the claims sufficiently recite the invention to render it *prima facie* patentable over the cited prior art. Therefore, Applicant invites the Examiner to suggest any additional claim limitations to Applicant's representative, Mike Dryja, at the phone number listed below, that if added to the claims would render the claims patentable to the satisfaction of the Examiner. Applicant does understand that this is not the Examiner's job per se, but submits that such a cooperative stance taken by the Examiner would be "win-win" for both Applicant and the Examiner. Applicant would receive an issued patent more quickly than if an adversarial stance were taken, and the Examiner would be able to remove this application from his docket without having to respond to any further responses or appeals on the part of Applicant.

Respectfully Submitted,



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Date

Michael A. Dryja, Reg. No. 39,662
Attorney/Agent for Applicant(s)

Law Offices of Michael Dryja
704 228th Ave NE #694
Sammamish, WA 98074
tel: 425-427-5094
fax: 206-374-2819